

PATENT
Application 09/528,693
Attorney Docket 2000P07518US01 (1009-026)

REMARKS

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 7-20 was previously cancelled without prejudice or disclaimer.

Claims 1-6 and 21-34 are now pending in this application. Each of claims 1 and 21 is in independent form.

I. Claim Construction

Before the *prima facie* obviousness criteria can be applied, the words of each claim must be interpreted. The Federal Circuit, in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*), *cert. denied*, 546 U.S. 1170, 126 S.Ct. 1332, 164 L.Ed.2d 49 (2006) has clarified that:

1. “[t]he Patent and Trademark Office (‘PTO’) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art’” (*Id.* at 1316);
2. the words of a claim “are generally given their ordinary and customary meaning” (*Id.* at 1312);
3. the ordinary and customary meaning of a claim term is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application” (*Id.* at 1313);
4. “the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification” (*Id.*);
5. even “the context in which a term is used in the asserted claim can be highly instructive” (*Id.* at 1314);
6. “the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor’s lexicography governs” (*Id.* at 1316);
7. even “when guidance is not provided in explicit definitional format, the specification

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may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents" (*Id.* at 1321);

8. an "invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office" (*Id.* at 1317 (*citing Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966))); and
9. the "prosecution history... consists of the complete record of the proceedings before the PTO and includes the prior art cited during the examination of the patent" (*Id.* at 1317).

The rules established in *Phillips* apply to *ex parte* examination in the USPTO. *See, In re Kumar*, 418 F.2d 1361 (Fed. Cir. 2005).

To the extent that the present Office Action presents legal arguments and analyzes claims using standards that differ from those of *Phillips*, Applicant respectfully traverses and respectfully requests a proper examination of the claimed subject matter.

II. The Claim Objections

Each of claims 32-50 was objected to under 37 CFR 1.75(c), as allegedly being of improper dependent form for failing to further limit the subject matter of a previous claim. The present Office Action alleges, at Page 5, "[t]he languages of 'adapted to' within the limitations are not required for the above steps/process to take place and therefore are not given any patentable weight (See MPEP 2106, Section II-C)." Each of these objections is respectfully traversed.

As an initial matter, in the present application each of claims 1-6 and 21-34 are currently pending. Yet the present Office Action purports to object to numerous non-existent claims by objecting to claims 32-50. Thus, the objection to the claims is not clear and requires clarification.

Further, with all due respect, the MPEP is not the law and sometimes does not even properly reflect the law, but instead presents aspirations and/or errors of the USPTO. The law, however, is created by Congress and the courts.

The predecessor court to the Federal Circuit has interpreted the phrase "adapted" as preceding a "structural limitation". *See, In re Venezia*, 530 F.2d 956 (CCPA 1976). Claim limitations preceded by "adapted" have been considered sufficiently definite. *See* MPEP

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2173.05(g).

In addition, the Federal Circuit has interpreted the word "adapted" as preceding "functional language [that] limits the scope of these claims to devices that have the capability of" performing the stated function. *See, R.A.C.C. Indus., Inc. v. Stun-Tech, Inc.*, 178 F.3d 1309, 49 USPQ2d 1793 (Fed. Cir. 1998) (*cert. denied*, 526 U.S. 1098 (1999)) (cited with approval by MPEP 2106.IV.B). Because such functional language serves as a claim limitation, a reference cited to support a rejection of a claim must describe a structure(s) capable of performing each claimed function preceded by the term "adapted."

Further, in the case of *In re Land*, the CCPA ruled on a relevant claim that stated "said color-providing substances associated with at least the inner photosensitive emulsion layers are *adapted to be rendered diffusible* in said liquid composition *only after at least substantial development* of the next outermost photosensitive ... layer has occurred." *See, In re Land*, 368 F.2d 866, 151 USPQ 621, 635 (CCPA 1966). The CCPA noted that the italicized portions of the claim were functional and held the claim patentable in view of the functional limitations.

In yet another case, the Federal Circuit reversed an Examiner's rejection of a patent claim due to the Examiner's failure to provide patentable weight to functional limitations. *See, In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Even if the objections were clear as to the identity of the claims objected to, binding precedent makes the objection substantively baseless. At least the cited holdings of the cases of *In re Venezia*, *R.A.C.C. Indus., Inc.*, *In re Land*, and *In re Mills* indicate that the assertions of the present Office Action regarding claim language following the phrase "adapted to" as being "optional" are legally erroneous. For at least these reasons, reconsideration and withdrawal to each objection to whatever claims the present Office Action actually intended to object to is respectfully requested.

III. The Obviousness Rejections

Each of claims 31-51 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable, over various combinations of U.S. Patent 5978773 ("Durst, Jr."), and/or U.S. Patent 6370563 ("Murakami"). Each of these rejections is respectfully traversed.

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A. Legal Standards

1. Rejection Clarity

The MPEP states that where "a claim is refused for any reason relating to the merits thereof it should be 'rejected' and the ground of rejection fully and clearly stated". *See* MPEP 707.07(d).

2. All Words in a Claim Must Be Considered

"To establish *prima facie* obviousness... '[a]ll words in a claim must be considered'". MPEP 2143.03, quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); *see also*, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

3. Next Office Action

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a "new grounds of rejection." Consequently, any Office Action containing such rejection can not properly be made final. *See*, *In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining "new ground of rejection" and requiring that "when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference"), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO "has the initial duty of supplying the factual basis for its rejection").

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B. Analysis

1. All Claims - Characterizations of the Claimed Subject Matter

To the extent that any past Office Action, the present Office Action, or any future Office Action attempts to characterize the subject matter of any claim without quoting the actual language of that claim, Applicant respectfully traverses.

2. All Claims – Lack of Clarity of Rejection

In the present application each of claims 1-6 and 21-34 are currently pending. Yet the present Office Action purports to reject numerous non-existent claims by rejecting claims 31-51. Thus, the rejection of the claims is not clear and the Office Action non-compliant with the requirements of at least MPEP 707.07(d).

In addition, the present Office Action appears to examine very little actual claim language of the pending claims. As another example of the lack of clarity of the present Office Action, at Page 6, the present Office Action purports to reject a limitation of "affixing a label to said predetermined product with said indicator disposed thereon". That language is not present in any of the pending claims. Because of the lack of actual claim language cited, the present Office Action fails to consider all words in all claims as required under case law such as that of *In re Wilson*, as cited, *supra*.

Moreover, the present Office Action refers to both U.S. Patent 5,978,773 and U.S. Patent Number 6,542,993 as "Durst Jr.". No person named "Durst Jr." is a listed inventor for U.S. Patent 5,978,773. This confusing naming convention makes it difficult for Applicant to assess the validity of the merits of the rejections.

Applicant declines to speculate regarding which claims the present Office Action actually intended to reject and/or which of the references denoted as "Durst Jr." provide the alleged grounds of any such rejections. For at least these reasons, a proper examination of the claimed subject matter is respectfully requested and a notice of allowability regarding the claimed subject matter is earnestly solicited.

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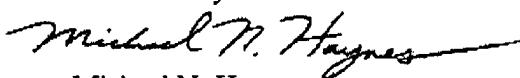
CONCLUSION

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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Date: 25 March 2008

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